

REMARKS

This is in response to the Office Action mailed on December 3, 2004, and the documents cited therewith. Claims 1 and 59 are amended. Accordingly claims 1 and 59-65 are now pending in the application. The claims are amended to clarify the subject matter that applicant regard as their invention. No new subject matter is added.

Information Disclosure Statement

Applicant submitted an Information Disclosure Statement and a 1449 Form on October 27, 2003. The Examiner indicated that the documents listed and initialed on the PTO-1449 have been reviewed, but all the listed documents were not present in the parent cases. Therefore, Applicant will need to resubmit the documents that were not considered by the Examiner. Applicant has attached the 1449 Form with the documents that were not considered by the Examiner and respectfully requests that initialed copies of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited documents have been considered by the Examiner.

Copies of the documents cited as Joceah, J. and Weiss, D. et al. are not enclosed as these documents were incorrectly cited and were cited previously and considered by the Examiner.

§112 Rejection of the Claims

Claims 1 and 59-65 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

Applicants have amended claim 1 and 59 in order to clarify the subject matter that is regarded as their invention. In claim 1 the "X" terms have been cancelled. In addition, the solid line intended to correspond with the optional double bond has been replaced by a dashed line in claim 1. As the Examiner indicated this was the result of a word processing error, and as

amended the claims are consistent with the specification. Claim 59 has been reformatted to keep the dashes that represent the optional double bond, “---,” together.

Accordingly, it is respectfully requested that the rejection under 35 USC § 112, second paragraph be withdrawn.

Double Patenting Rejection

Claims 1 and 59-65 were rejected under the judicially created doctrine of obviousness – type double patenting as being allegedly unpatentable over claims 25-31 of U.S. Patent No. 5,932,553.

To overcome this rejection, while not conceding the obviousness of any of the pending claims over the claims of U.S. Patent No. 5,932,553, applicants submit a terminal disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) herewith. The Examiner is requested to note that Applicants are disclaiming the terminal part of the statutory term of any patent granted on the above-identified patent application (Serial No. 10/694,533), which would extend beyond the expiration date of the full statutory term, as presently shortened by any terminal disclaimers, of U.S. Patent No. 5,932,553. Withdrawal of this rejection is therefore appropriate and is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6968 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

TREVOR C. MCMORRIS ET AL.

By their Representatives,

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Minneapolis, MN 55402
(612) 373-6968

Date March 16, 2005

By William F. Prout
William F. Prout
Reg. No. 33,995

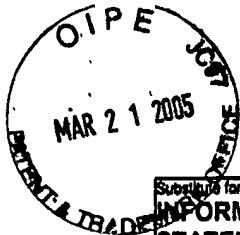
CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16th day of March, 2005.

Dawn M. Poole

Name

Dawn M. Poole

Signature



Substitute for form 1449A/PTO
**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(Use as many sheets as necessary)

Complete if Known

Application Number	10/694,533
Filing Date	October 27, 2003
First Named Inventor	McMorris, Trevor
Group Art Unit	1614-1623
Examiner Name	Maier, Leigh

Sheet 1 of 6

Attorney Docket No: 103.006US5

US PATENT DOCUMENTS

Examiner Initial *	USP Document Number	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	Filing Date If Appropriate
LCM	US-4,559,157	12/17/1985	Smith, James A., et al.	252	90	04/21/1983
LCM	US-4,608,392	08/26/1986	Jacquet, Bernard, et al.	514	844	08/28/1984
LCM	US-4,612,302	09/16/1986	Szabo, Sandor, et al.	514	11	11/14/1983
LCM	US-4,684,620	08/04/1987	Hruby, Victor J., et al.	514	11	09/04/1984
LCM	US-4,820,508	04/11/1989	Wortzman, Mitchell S.	424	59	06/23/1987
LCM	US-4,853,371	08/01/1989	Coy, David H., et al.	514	12	08/22/1988
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LCM	US-5,387,578	02/07/1995	Angelucci, F., et al.	514	21	02/20/1992
LCM	US-5,439,936	08/08/1995	Kelner, M. J., et al.	514	546	02/09/1993
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LCM	US-5,563,176	10/08/1996	Kelner, M. J., et al.	514	691	07/15/1994
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LCM	US-6,639,105	10/28/2003	McMorris, T. C., et al.	562	3553	04/29/2002

FOREIGN PATENT DOCUMENTS

Examiner Initials *	Foreign Document No	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	T ²
LCM	EP-0915819B1	05/26/2004	McMorris, T. C., et al.	C07C	49/737	
	HU 208115B	05/28/1991	Maecher, Ingolf			
LCM	JP-62-234040	10/14/1987	Shotard, Ono	C07C	49/737	
LCM	WO-91/04754	04/18/1991	Kelner, M. J., et al.	A61K	47/48	
LCM	WO-9104754A2	04/18/1991	Kelner, M. J., et al.	A61K	47/48	
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LCM	WO-94/25013	11/10/1994	Cousins, R. D., et al.	A61K	31/075	
LCM	WO-96/34005	10/31/1996	Danishefsky, Samuel J., et al.	C07H	15/24	
LCM	WO-97/03995	02/06/1997	Danishefsky, Samuel J., et al.	C07H	15/24	
LCM	WO-98/03458	01/29/1998	McMorris, T. C., et al.	C07C	49/737	

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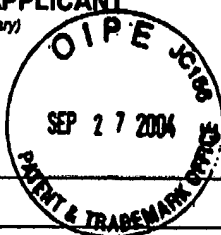
Leigh C. Maier

DATE CONSIDERED 11-22-04

Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)



Sheet 2 of 6

Complete if Known

Application Number	10/694,533
Filing Date	October 27, 2003
First Named Inventor	McMorris, Trevor
Group Art Unit	1614 1623
Examiner Name	Maier, Leigh
Attorney Docket No:	103.006US5

FOREIGN PATENT DOCUMENTS

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LCM	WO-WO91/04754	04/18/1991	Kelner, M. J., et al.	A61K	47/48	

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
LCM		European Search Report from European Application No. 04 01 2220, dated 15 July 2004, 5 pgs	
LCM		ANCHEL, MARJORIE, et al., "Antibiotic Substances From Basidiomycetes. VII. Clitocybe Illudens", <u>Proceedings of the National Academy of Sciences</u> , 36 (5), (1950),300-305	
LCM		ANCHEL, M., et al., "The Biogenesis of Illudins S and M in Clitocybe Illudens", <u>Phytochemistry</u> , 9(11), (November 1970),2339-2343	
LCM		ARAP, WADIH, et al., "Cancer Treatment by Targeted Drug Delivery to Tumor Vasculature in a Mouse Model", <u>Science</u> , 279(5349), (January 16, 1998),377-380	
LCM		BRANDSTETEROVA, E., et al., "HPLC Analysis of Novel Anti-Cancer Agents-Illudens and Their Analogs", <u>Journal of Liquid Chromatography</u> , 16 (1), (1993),pp. 115-125	
LCM		BRANDSTETEROVA, E., et al., "HPLC Determination of a New Anticancer Agent (Acylfulvene) in Serum", <u>Neoplasma</u> , 39 (6), (1992),pp. 369-373	
LCM		BURRES, N. S., et al., "Antitumor Activity and Mechanism of Action of the Novel Marine Natural Products Mycalamide-A and -B and Onnamide", <u>Cancer Research</u> , 49, (June 1989),2935-2940	
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LCM		GOLDIN, A., et al., "Current Results of the Screening Program at the Division of Cancer treatment, National Cancer Institute", <u>Europ. J. Cancer</u> , 17, (1981),pp. 129-142	

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Leigh C. Maier

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Substitute Disclosure Statement Form (PTO-1449)

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. Applicant's unique citation designation number (optional) > Applicant is to place a check mark here if English language Translation is attached

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 2px;">Complete if Known</td> </tr> <tr> <td style="width: 50%; padding: 2px;">Application Number</td> <td style="padding: 2px;">10/694,533</td> </tr> <tr> <td style="padding: 2px;">Filing Date</td> <td style="padding: 2px;">October 27, 2003</td> </tr> <tr> <td style="padding: 2px;">First Named Inventor</td> <td style="padding: 2px;">McMorris, Trevor</td> </tr> <tr> <td style="padding: 2px;">Group Art Unit</td> <td style="padding: 2px;">1614 1623</td> </tr> <tr> <td style="padding: 2px;">Examiner Name</td> <td style="padding: 2px;">Maier, Leigh</td> </tr> </table>	Complete if Known		Application Number	10/694,533	Filing Date	October 27, 2003	First Named Inventor	McMorris, Trevor	Group Art Unit	1614 1623	Examiner Name	Maier, Leigh
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Sheet 3 of 6	Attorney Docket No: 103.006US5												

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
LCM		GOLDIN, A. , et al., "Historical Development and Current Strategy of the National Cancer Institute Drug Development Program", In: <u>Methods in Cancer Research</u> , Vol. XVI, Cancer Drug Development Part A, Chapter V, Academic Press, Inc., New York, (1979), pp. 165-245	
LCM		GREENE, T. W., <u>Protective Groups in Organic Synthesis</u> , Chapters 4, 5 & 6, John Wiley & Sons, Inc., New York, (1981), pp. 114-217	
LCM		HANSON, J. R., et al., "Studies in Terpenoid Biosynthesis. Part XV. Biosynthesis of the Sesquiterpenoid Illuden M", <u>Journal of the Chemical Society, Perkin Transactions I</u> , (1976), 876-880	
LCM		HARA, M. , et al., "6-Deoxyilluden M, a New Antitumor Antibiotic: Fermentation, Isolation and Structural Identification", <u>The Journal of Antibiotics</u> , 40, (Nov. 1987), pp. 1643-1646	
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LCM		HIRONO, I. , et al., "Reproduction of Acute Bracken Poisoning in a Calf with Ptaquiloside, a Bracken Constituent", <u>The Veterinary Record</u> , 115 (15), (Oct. 1984), pp. 375-378	
LCM		INOUE, K. , et al., "Antitumor Efficacy of Seventeen Anticancer Drugs in Human Breast Cancer Xenograft (MX-1) Transplanted in Nude Mice", <u>Cancer Chemother. Pharmacol.</u> , 10, (1983), pp. 182-186	
LCM		KAWATO, Y. , et al., "Antitumor Activity of a Camptothecin Derivative, CPT-11, Against Human Tumor Xenografts in Nude Mice", <u>Cancer Chemother. Pharmacol.</u> , 28, (1991), pp. 192-198	
		KELNER, M. J., et al., "In Vitro and In Vivo Studies on the Anticancer Activity of Dehydroilluden M", <u>Anticancer Research</u> , 15, (1995), pp. 873-878	
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LCM		KELNER, M. J., et al., "Preclinical Evaluation of Illudens as Anticancer Agents", <u>Cancer Research</u> , 47, (1987), pp. 3186-3189	
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LCM		LU, JIANLIANG , et al., "An expeditious synthesis of the potent antitumor agent, (+)-hydroxymethylacylfulvene using an allenic Paulson-Khand type cycloaddition", <u>American Chemical Society, Division of Organic Chemistry Abstracts</u> , 217th ACS National Meeting in Anaheim, CA, (Mar. 21-25, 1999), 1 p.	

EXAMINER

Leigh C. Maier

DATE CONSIDERED 11-22-04

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Attorney Docket No: 103.006US5

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LCM		MATSUMOTO, TAKESHI, et al., "An Alternative Synthesis of Illudin M", <u>Tetrahedron Letters</u> , 14, (March 1970), pp. 1171-1174	
LCM		MATSUMOTO, T., et al., "Synthesis of Illudin S", <u>Tetrahedron Letters</u> , 23, (May 1971), pp. 2049-2052	
		MCMORRIS, T. C., et al., "(Hydroxymethyl) Acyfulvene: An Illuden Derivative with Superior Antitumor Properties", <u>Journal of Natural Products</u> , 59 (9), (Sept. 1996), pp. 896-899	
LCM		MCMORRIS, T. C., et al., "(Hydroxymethyl)acyfulvene: An Illudin Derivative with Superior Antitumor Properties", <u>Chemical Abstracts</u> , abstract No. 196032, Vol. 125, No. 15, (October 7, 1996),	
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LCM		MCMORRIS, T. C., et al., "Design and Synthesis of Antitumor Acyfulvenes", 62 (9), Deptt. of Chemistry and Biochemistry, University of California, (Jan. 27, 1997), 3015-3018 <i>J. Org. Chem.</i>	
LCM		MCMORRIS, T. C., et al., "Fungal Metabolites. The Structures of the Novel Sesquiterpenoids Illudin -S and -M", <u>J. of Amer. Chem. Soc.</u> , 87 (7), (1965), pp. 1594-1600	
LCM		MCMORRIS, T. C., et al., "Hydroxymethyl Acyfulvene: An Illudin Derivative with Superior Antitumor Properties", 125 (15), (Oct. 7, 1997), 1251 <i>J. Nat. Prod.</i>	
LCM		MCMORRIS, T. C., et al., "Metabolism of Antitumor Acyfulvene by Rat Liver Cytosol", <u>Biochemical Pharmacology</u> , 57, (1999), pp. 83-88	
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Substitute Disclosure Statement Form (PTO-1448)

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 508. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. Applicant's unique citation designation number (optional) : Applicant is to place a check mark here if English language Translation is attached

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Sheet 5 of 6

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OTHER DOCUMENTS – NON PATENT LITERATURE DOCUMENTS

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LCM		PADWA, ALBERT, et al., "An approach toward the illudin family of sesquiterpenes using the tandem cyclization-cycloaddition reaction of rhodium carbenoids", <u>The Journal of Organic Chemistry</u> , 62 (5), (March 7, 1997),pp. 1317-1325	
LCM		PADWA, ALBERT, et al., "Generation and Cycloaddition behavior of spirocyclic carbonyl ylides. Application to the synthesis of the Pterisin Family of Sesquiterpenes", <u>The Journal of Organic Chemistry</u> , 61 (1), (Jan. 12, 1996),pp. 73-81	
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LCM		SCHABEL, F. M., et al., "Testing Therapeutic Hypotheses in Mice and Man: Observations on the Therapeutic Activity Against Advanced Solid Tumors of Mice Treated with Anticancer Drugs that Have Demonstrated or Potential Clinical Utility for Treatment of Advanced Solid Tumors of Man", In: <u>Methods in Cancer Research</u> , Vol. XVII, Cancer Drug Development Part B, Chapter 1, Academic Press, Inc., (1979),pp. 3-50	
		SHIMOMURA, O., "The Role of Superoxide Dismutase in Regulating the Light Emission of Luminescent Fungi", <u>The Journal of Experimental Botany</u> , 43 (256), (Nov. 1992),pp. 1519-1525	
LCM		SHINOZAWA, S., et al., "The Antitumor Effect of illudin S (Lampterol) Entrapped in Liposome for Mice Inoculated with Ehrlich Ascites Tumor Cells", <u>Chemical Abstracts</u> , 90 (25), Abstract No. 197682m, (June 18, 1979), 1 p.	
LCM		STEEL, G. G., et al., "The Response to Chemotherapy of a Variety of Human Tumor Xenografts", <u>Br. J. Cancer</u> , 47, (1983),pp. 001-013	
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LCM		TANAKA, K., et al., "Metabolism of illuden S, a Toxic Principle of Lampteromyces Japonicus, by Rat Liver. I. Isolation and Identification of Cyclopropane Ring-Cleavage Metabolites", <u>Xenobiotica</u> , 20 (7), (1990),pp. 671-681	
LCM		TANAKA, KEN, et al., "Michael-type addition of illudin S, a toxic substance from Lampteromyces japonicus with Cysteine and Cysteine-containing peptides in vitro", <u>Chem. Pharm. Bull.</u> , Vol. 44, No. 2, (1996),pp. 273-279	
LCM		VARKI, N. M., et al., "Cloned Low Metastatic Variants from Human Lung Carcinoma Metastases", <u>Anticancer Research</u> , 10, (1990),pp. 637-644	
LCM		VENDETTI, J. M., et al., "Current NCI Preclinical Antitumor Screening in Vivo: Results of Tumor Panel Screening, 1976-1982, and Future Directions", <u>Advances in Pharmacology and Chemotherapy</u> , 20, (1984),pp. 1-20	

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Examiner Name	Maier, Leigh												
Sheet 6 of 6	Attorney Docket No: 103.006US5												

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
LCM		VENDITTI, J. M., "The National Cancer Institute Antitumor Drug Discovery Program, Current and Future Perspectives: A Commentary", <u>Cancer Treatment Reports</u> , 67 (9), (Sept. 1983), pp. 767-772	
LCM		WALSER, J. , et al., "Mode of Action of Illuden S", <u>Antimicrobial Agents and Chemotherapy</u> , 3 (3), (March 1973), pp. 357-363	
LCM		WEINREB, S. M., "Fulvenes Derived from Illuden S", <u>Tetrahedron Letters</u> , 38, (Sept. 1971), pp. 3489-3491	
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Application Number	Unknown
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First Named Inventor	McMorris, Trevor
Group Art Unit	Unknown 1623
Examiner Name	Maier, Leigh

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Application Number	Unknown
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First Named Inventor	McMorris, Trevor
Group Art Unit	Unknown 1623
Examiner Name	Maier, Leigh

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First Named Inventor	McMorris, Trevor
Group Art Unit	Unknown <i>then 1623</i>
Examiner Name	Maier, Leigh

Sheet 3 of 5

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Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T
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Application Number	Unknown
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First Named Inventor	McMorris, Trevor
Gr up Art Unit	Unknown 1623
Examiner Name	Maier, Leigh

Sheet 4 of 5

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OTHER DOCUMENTS – NON PATENT LITERATURE DOCUMENTS

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Application Number	Unknown
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Group Art Unit	Unknown 1623
Examiner Name	Maier, Leigh

Sheet 5 of 5

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